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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/664,247	09/18/00	ELSNER	W 2384/001440

HM12/1109

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EXAMINER

MCCORMICK, S

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/664,247

Applicant(s)

ELSNER, WILHELM

Examiner

Susan B. McCormick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Septembet 18, 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Detailed Action

The substitute specification, supplemental response and duplicate drawing have been received and entered on October 5, 2001 as paper no. 4.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

35 U.S.C. § 112

1st and 2nd Paragraphs

The rejection of claim 1 under 35 U.S.C. 112 (paper 3) is withdrawn in view of Applicant's amendment.

Claim Rejections- 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right application no. 970950 (European Community) in view of Applicant's admission that 'Pendec' was sold in Germany in July 1998 (page 2 of reply filed October 5, 2001).

The application was published on December 15, 1997, more than one year prior to filing of instant application. The application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See MPEP § 2128. The Federal Office of Plant Varieties publishes applications for variety protection. Once the Breeder's Grant is made, the variety and description are entered in the Plant Variety Protection Register. The register, grant and published applications are accessible to the public.

Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publications standing alone would

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not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied on to show that the primary reference has an "enabled disclosure." *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). See also MPEP § 2131.01. When the claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the 'Siokra' cultivar disclosed in the cited publications."). See also MPEP § 2121.03.

Applicant admits on page 2 of the response filed October 5, 2001 that the cultivar Pendec was sold in Germany as early as July 1998. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application's U.S. filing date. It is enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson, supra*. See also Cooper, *Biotechnology and the Law* § 8.05 (1998 Clark Boardman Callaghan). "In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public."

Response to Argument

Applicant's arguments have been considered as they apply to the new ground of rejection.

Applicant argues that it is improper to combine references. This argument is not persuasive because there is no combination of references.

Applicant argues that "By the weight of authority, the description must enable such a person not only to comprehend the invention but also to make it." This argument is not persuasive since the reference, combined with the knowledge of one skilled in the art, puts the skilled artisan in possession of the claimed invention. "...The proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it

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with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought.” *In re LeGrice*, 133 USPQ 365 (CCPA 1962).

Applicant argues that a Plant Breeder’s Right Certificate does not contain the same type or same volume of information that a plant patent contains. This argument is not persuasive because a better description of the claimed invention does not confer novelty. See MPEP 2112.

Applicant argues that the plant in *In re LeGrice* was available only in a foreign country, and that the fact situation is the same in the instant application. This argument is not persuasive because in *LeGrice*, Applicant never admitted that the rose cultivar was on sale anywhere. Instead, Applicant stated “Prior public use or sale are the avenues by which a plant enters the public domain” (*Le Grice*, p. 372). The court then added “section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter” (p. 372).

Applicant’s contention that the Court knew the claimed plant had been on sale and found that fact irrelevant is contrary to the written opinion cited above. The *LeGrice* decision repeatedly returns to the question of whether the invention was “in the possession of the public.” Clearly, if an invention is on sale to the public, then the public must have possession of it. As stated by the Board of Appeals and Interferences in *Ex parte Thomson*, “the court’s holding was based on the specific ‘printed publications’ before it, and no indication was given that the ‘prior catalogue publication’ before it evidenced commercial availability in a readily enabling form” (p. 1622).

Applicant further argues that the reference does not provide an enabling disclosure. In the instant application, the printed publication cited in the rejection above informs the public of the existence of the claimed plant and provide some description. Applicant has admitted that the skilled artisan could have obtained the plant through normal distribution channels, at least in the European Community as early as 1998. Having obtained the plant, the skilled artisan would have been able to “make” the claimed invention by vegetative propagation of the purchased material, using methods well known in the art. Thus the publication cited in the rejection above provides an enabling disclosure.

Applicant argues that the examiner should not rely on *Ex parte Thomson*, because that case involved an application for a utility patent. This argument is not persuasive because the question in *Thomson*, as in *LeGrice*, was, what is required to “enable” a printed publication describing a plant? Except for the type of patent sought, the instant application presents the same fact pattern as the *Thomson* case. Moreover, Applicant has misconstrued the *Thomson* decision. The printed publications cited in *Thomson* were not enabled by Applicant’s deposit of seeds, but by commercial availability of the seeds outside the U.S. As stated in *Thomson*, “we are convinced that the skilled cotton grower would have had

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the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercial available Siokra seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e., Siokra plants, seeds and pollen.” Also, “It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market.”

Applicant argues that the claimed plant was not available in the U.S. This argument is not persuasive. Applicant is attempting to create a geographic component of enablement, which does not exist in statute or case law. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the U.S. See, for example, *Ex parte Rinehart* (10 USPQ2d 1710), where a specification was found to be enabling even though the required biological material was only available in the ocean off the coast of Central and South America. Even if there were a requirement that the plant be available in the U.S., Applicant has not explained why the skilled rose grower could not have purchased the claimed plant and arranged for its importation into the U.S. through the usual channels (customs and USDA quarantine).

Applicant argues that one needs access to the claimed plant in order to reproduce it. This argument is not persuasive because the plant was made accessible by virtue of its sale to the public.

Applicant argues that testing of the claimed invention is required. Field trials or other testing of a plant variety are not a bar to patentability, so long as the plant is not placed in the public domain. In the instant application, however, Applicant has admitted that the claimed plant was placed in the public domain (through its sale) more than one year prior to filing for a U.S. plant patent.

Summary

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and alternate Fridays from 7:00 a.m. to 3:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

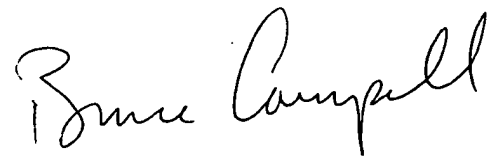
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Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm

A handwritten signature in cursive script that reads "Bruce Campell".

**BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**